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Paper 60
ENTERED: 24 February 2011

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,684

Horacio L. Rodriguez RILO
and Arthor J. Helmicki
(11/748,735),
Junior Party,

v.

Daniel J. BENEDICT
and Lorna S. Mosse
(US 7,045,349),
Senior Party.

Before: RICHARD TORCZON, SALLY G. LANE and MICHAEL P.
TIERNEY, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

JUDGMENT
Bd.R. 127
on the merits

The all involved claims of both parties have been held unpatentable.
Hence, it is appropriate to proceed to judgment.

JUDGMENT is ENTERED AGAINST the junior party (Rilo) for count 1, the sole count;¹

JUDGMENT is ENTERED AGAINST the senior party (Benedict) for count 1;

Claims 62-70 and 74-80 of Rilo's involved 11/748,735 application are FINALLY REFUSED;² and

Claims 1-50 of Benedict's involved 7,045,349 patent are CANCELED.³

A copy of this judgment will be entered in the administrative records of the involved patent and the involved application.

cc:

John Garred, Susan Mizer, and Michael Hudzinski, TUCKER ELLIS & WEST LLP, of Cleveland, Ohio, for junior party Rilo.

Robert Hahl and Rick Neifeld, NEIFELD IP LAW, PC, of Alexandria, Virginia, for senior party Benedict.

¹ Paper 1 at 3.

² 35 U.S.C. 135(a).

³ *Id.*

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Before RICHARD TORCZON, SALLY G. LANE and MICHAEL P.
TIERNEY, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION
Bd.R. 125
on motions

The senior party (Benedict) seeks judgment against junior party (Rilo)
on the bases of written description, obviousness and repose.

Benedict motion 1 (Obviousness) is GRANTED;

Benedict motion 2 (Written description) is GRANTED and Rilo involved claims 62-70 and 74-79 are ADJUDGED UNPATENTABLE; and Benedict motion 4 (Repose) is DENIED.

MEMORANDUM OPINION

I. INTRODUCTION

All of the pending motions focus on Rilo's involved claims. All of Rilo's pending claims (62-70 and 74-80) are involved.¹ In response to Benedict's written description motion, Rilo has asked for judgment against all of its own claims except claim 80.²

Count 1, the sole count, is the method of claim 80 of the 11/748,735 application.³ Claim 80 defines the invention as:⁴

80. A method for isolating islets from a portion of a pancreas, comprising:

introducing the portion of a pancreas to an islet processing solution that contains a digestive enzyme and that is characterized by a plurality of process control variables, said plurality of process control variables including a temperature, a flowrate, a pH, and a pressure;

circulating said islet processing solution around and through the portion of a pancreas and past a plurality of sensors, said plurality of sensors being exposed to said islet processing solution having an output that characterizes a state of one of the process control variables;

¹ Paper 1 (Decl'n) at 3.

² Paper 42 (Rilo Opp. 2) at 1.

³ Paper 1 at 3.

⁴ Paper 9 (Rilo clean claims).

monitoring said plurality of process control variable of the islet processing solution during islet isolation via a process controller;

controlling said temperature, flowrate, and pressure of the islet processing solution during islet isolation with the process controller that is in communication with said plurality of sensors, said process controller having a process control interface and configured to change the state of said plurality of process control variables; separating the islets from the portion of pancreas; and

collecting the separated islets.

II. WRITTEN DESCRIPTION

Benedict moves for judgment that all involved Rilo claims except claim 80 fail to comply with the written description requirement of 35 U.S.C. 112(1).⁵ Rilo consents to judgment against these claims on this ground.⁶ A party may consent to judgment against itself.⁷ The board has the discretion to accept a concession. On the present record, we see no reason not to accept Rilo's concession.

⁵ Paper 25 (Benedict Mot. 2).

⁶ Paper 42 at 1.

⁷ Bd.R. 127(b). In Paper 37 (Dec'n on Benedict Mot. 3) at 9-10, the board explained that it was not obligated to grant an unopposed motion. In its Motion 3, Benedict was seeking to end the interference and Rilo simply did not oppose: the requested judgment was not *against* either party and thus did not involve a concession by either. By contrast, for Benedict motion 2, Rilo has actively given up most of its claims. Since one may always give up claims for any reason, *cf.* 35 U.S.C. 132(a) & 253, and since there does not appear to be any prejudice to the public or to the integrity and efficiency of the proceeding, there appears to be no reason to deny this motion.

III. OBVIOUSNESS

A. Introduction

Benedict moves for judgment that claim 80 is not patentable over the prior art,⁸ relying on the teachings of United States patents to Mullen,⁹ Kearney¹⁰ and Shuler.¹¹ Rilo contends that Benedict is barred from making this argument, that the references cannot properly be combined and, alternatively if they can be combined, that they apply to Benedict's involved claims as well.

B. Facts and findings

1. *Mullen*

Mullen addresses a "method, a solution and a chamber for the preparation and storage of pancreatic islets."¹² Mullen teaches "an intermittent two-step digestion procedure for pancreatic tissue and includes warm and cold digestion steps."¹³ Specifically, Mullen prefers using a collagenase solution.¹⁴

[1] We note that collagenase is an enzyme that digests the connective tissue collagen.

⁸ Paper 24 (Benedict Mot. 1) at 4.

⁹ Exh. 1005: Y. Mullen & T. Kenmochi, *Preparation and storage of pancreatic islets*, U.S. Patent 5,919,703 (granted 6 July 1999).

¹⁰ Exh. 1006: G.P. Kearney, *Automated cell culture and testing system*, U.S. Patent 5,424,209 (granted 13 June 1995).

¹¹ Exh. 1007: M.L. Shuler et al., *Automated multicompartmental cell culture system*, U.S. Patent 5,612,188 (granted 18 March 1997).

¹² Mullen at Abstract & 1:13-14 (Field of Invention).

¹³ *Id.* at 2:34-37.

¹⁴ *Id.* at 2:59-64.

Mullen's Example 1 teaches transporting harvested pancreata in a cold solution with a pH of 7.4.¹⁵ The example teaches injecting a warm (37° C) collagenase solution at a pH of 7.2 into the ducts of the pancreata and then gently agitating pancreas pieces in a warm solution.¹⁶ After initial digestion, the collagenase solution is filtered and the digested tissue is digested in a cold solution with a pH of 7.3.¹⁷ The cycle of warm and cold digestion steps are repeated until most of the islets are free, taking approximately 60 minutes.¹⁸ In Table I, Mullen provides the details of the four solutions used in the example. Various factor are specified for the protection of the islets: impermiants (osmotic protectants), hydrogen ion buffers (pH controls), metabolites and related factors and sodium and potassium ion levels.¹⁹ Mullen teaches periodically monitoring the temperature of the cold digestion solution.²⁰

[2] Mullen differs from the claimed invention because it teaches manual batch processing rather than automated processing and thus is not concerned with flowrate and pressure.

2. Kearney

Kearney discloses a self-contained system for culturing, maintaining and testing living cells and tissue. Kearney teaches the use of several containment levels, including positive pressure, to avoid contamination. The system is so robust and independent of its environment that it can operate

¹⁵ Mullen at 5:37-6:2.

¹⁶ *Id.* at 6:6-17.

¹⁷ *Id.* at 6:19-30.

¹⁸ *Id.* at 6:32-41.

¹⁹ *Id.* at 6:47-7:10 & 10:35-11:61.

²⁰ *Id.* at 14:45-49.

without regard to orientation in the microgravity of Earth orbit. The system can operate with a wide variety of cell and tissue types including plant tissues, animal tissues and microorganisms.²¹

Kearney teaches in-line detectors and monitoring devices to continuously assess cell viability and adjust all life-sustaining factors, including oxygen and nutrient levels and temperature.²² Temperature control is accurate to within 0.5° C.²³ Fluid pathways are carefully controlled, with pressurized reservoirs and pumps and valves that allow control of fluid administration and removal.²⁴ Kearney uses pH, temperature and pressure sensors to aid a digital controller in automatically controlling the system.²⁵

[3] Kearney differs from the claimed invention in its general purpose, covering a broad range of functions with a broad range of cells and tissues, rather than the specific purpose of isolating intact pancreas islets.

3. *Shuler*

Shuler discloses a closed, automatic system for evaluating substances on a variety of different cell types.²⁶ The system is designed to allow circulation between cell types, such as liver cells and target cells, to better model the behavior of a substance in a living being.²⁷ Shuler uses pumps, valves and flow meters to control circulation.²⁸ A heater and temperature

²¹ Kearney at abstract and 4:47-5:12.

²² *Id.* at 5:21-28.

²³ *Id.* at 6:24-41.

²⁴ *Id.* at 5:57-6:8, 7:10-21 and 10:46-11:16.

²⁵ *Id.* at 18:1-19.

²⁶ Shuler at 2:14-29.

²⁷ *Id.* at 2:49-56.

²⁸ *Id.* at 6:20-39 and 9:3-7.

probe are used to regulate temperature.²⁹ Other sensors may be used to monitor the effects of the substance on cells, including spectrophotometers, pH meters, fluorometers and turbidity meters.³⁰

[4]

4. Other facts and findings

Controlling pressure in a fluid pathway necessarily regulates flowrate.³¹

[5] Mullen provides evidence that those skilled in the art could successfully isolate viable pancreas islet cells in a manual, batch-processing system.

[6] Kearney provides evidence of a very high level of skill in designing closed automated systems for culturing, maintaining and testing a wide variety of tissues and cells.

[7] Shuler provides similar evidence of high skill in designing closed automated systems for maintaining and testing related animal cells.

[8] All three reflect the recognition in the art of the need, and the ability, to monitor factors related to the continuing viability of cells, including temperature and pH.

[9] Kearney and Shuler reflect the recognition in the art of the need, and the ability, to monitor and control pressure and flowrate in an automated closed system with multiple process steps.

Rilo's opposition does not point to any particular problem in automating the claimed process that they overcame to perfect the invention;

²⁹ *Id.* at 6:46-50.

³⁰ *Id.* at 6:60-67.

³¹ Paper 45 (Benedict Reply 1), mat'l fact 26.

rather, Rilo expresses confidence "that modifications will readily occur to those skilled in the art, within the spirit of the invention and the scope of the appended claims."³²

[10] Rilo's disclosure is consistent with a high level of skill in the art.

A high level of skill is also consistent with our previous finding when deciding Benedict Motion 3 denying judgment of no interference-in-fact.³³

Neither party provides evidence of commercial success, unexpected results or other secondary considerations.

C. Analysis

Rilo focuses on Kearney and Shuler, arguing that there is no reason to combine their teachings with Mullen's teachings and that they do not provide all that is missing from Mullen's teachings.³⁴ Rilo also contends that if its claims are unpatentable over these references, then Benedict's claims are as well.³⁵

1. Estoppel

Rilo argues that Benedict is estopped from contending that these references can be combined.³⁶ The question before us is patentability, not validity or priority. Patentability determinations are ultimately the responsibility of the Director of the United States Patent and Trademark

³² Exh. 1002: H.L.R. Rilo et al., *Cell separation apparatus*, US 2007/0218553 A1 at ¶0114 (pub'd 20 September 2007).

³³ Paper 37 at 4-6, relying on testimony from D.W. Piston (Exh. 1001).

³⁴ Paper 41 (Rilo Opp. 1) at 1-6.

³⁵ *Id.* at 6.

³⁶ *Id.* at 1-3.

Office and the board.³⁷ Consequently, whatever estoppel might apply against Benedict cannot be extended to the board.³⁸ We could exercise our discretion to reach the issue under Board Rule 121(f). Since the issue has already been briefed, giving effect to Benedict's putative estoppel would simply add to the expense and delay in resolving the issue.

Benedict had argued that Mullen's only automatic step was the gentle agitation during the warm digestion step so a person having ordinary skill in the art would have no motivation to believe additional automation would be needed or effective with pancreatic tissue.³⁹ This argument applied to Rilo claim 80 is not compelling given the strong general teachings of Kearney and Shuler, along with the high level of skill they imply. Updating existing technology is a well-established reason to combine teachings.⁴⁰ Kearney and Shuler suggest that the art had ample skill and knowledge to automate Mullen's process.

³⁷ 35 U.S.C. 6(b), 135(a) and especially 135(d) (exempting patentability determinations in arbitrations from binding the Director "in interferences"). The Director has codified his expectation that the board may consider patentability independently of the parties. Bd.R. 121(f) and 126(a).

³⁸ *Office of Pers. Mgmt. v. Richmond*, 496 U.S. 414, 419-20 (1990) (explaining that there is a strong presumption against estopping the Federal government); *accord In re Borkowski*, 505 F.2d 713, 718 (CCPA 1974) (holding earlier reversal in a related case did not estop the board from affirming a rejection).

³⁹ Exh. 2007: Benedict corresp. of 10 March 2005 at 26-27.

⁴⁰ *E.g., Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (updating analog device by use of electronics).

2. Adequacy of the automation teachings

Rilo argues that islets are pressure sensitive, hence, control of pressure is a key feature of the claimed method.⁴¹ Rilo correctly notes that some portions of Kearney and Shuler that Benedict cites do not have much bearing on this problem.⁴²

Mullen at least suggests the importance of pressure to islet viability in its focus on the use of impermeants in solutions to regulate external osmotic pressure. Moreover, there is no indication that islets are uniquely sensitive to pressure (or to mechanical damage, such as shearing, that might be related to pressure and flow). Both Kearney and Shuler teach flow control and use of appropriate sensors to ensure cell viability. Rilo has acknowledged the relationship between flow and pressure, which Kearney alludes to in any case.⁴³ Shuler teaches flow meters. Given the high level of skill shown in Kearney and Shuler, it seems unlikely that a person having ordinary skill in the art would have difficulty making appropriate adjustments to monitoring flow and pressure when working with islets.

Rilo makes similar arguments with regard to flowrate, temperature and pH.⁴⁴ As noted in the preceding paragraph, flowrate and pressure are interrelated problems. While the specific solutions taught in Kearney and Shuler might not have direct bearing on automating Mullen's process, they suggest knowledge and ability in the art to address known problems of monitoring and controlling pressure and flow.

⁴¹ Paper 41 at 3.

⁴² *Id.* at 3-4.

⁴³ Kearney at 8:66-9:3.

⁴⁴ Paper 41 at 4-5. In fact no argument specific to pH is apparent.

Temperature is central to Mullen's process and pH is a repeatedly cited factor. Once again, whether the specific solutions of Kearney and Shuler could be used in Mullen's process is not the test; rather, they are relevant for what they show about the knowledge and ability in the art to address these factors that Mullen identified.

Rilo has provided testimony from Luis Fernandez in support of its arguments. Dr. Fernandez identifies many of the differences between what Kearney and Shuler are doing and the claimed method. Dr. Fernandez does not, however, explain why the teachings and suggestions of Kearney and Shuler could not be successfully adapted to automate Mullen's method. Both Kearney and Shuler suggest that the art takes a much higher level of skill for granted in automating cell processing systems. The testimony of Dr. Fernandez is not wrong so much as it is too narrow in focus to be very probative.

3. Conclusion

The subject matter of Rilo claim 80 would have been obvious to a person having ordinary skill in the art.

D. Benedict's claims

Because interfering claims are presumed to define the same invention, a movant urging the unpatentability over prior art of its opponent's claims must provide reasons why its own claims are not similarly unpatentable.⁴⁵ Benedict provides reasons in terms of its two independent claims (emphasis of contested terms added):⁴⁶

⁴⁵ Bd.R. 207(c).

⁴⁶ Paper 24 at 13-14.

1. A method for isolating islets from a portion of a pancreas, comprising:

introducing the portion of a pancreas to an islet processing solution that contains a digestive enzyme and that is characterized by a plurality of process control variables;

circulating said islet processing solution around and through the portion of a pancreas and past a plurality of sensors, said plurality of sensors being exposed to said islet processing solution having an output that characterizes a state of one of the process control variables;

controlling said plurality of process control variables of the islet processing solution during islet isolation with a process controller that is in communication with said plurality of sensors, said process controller having a process control interface and being capable of changing the state of said plurality of process control variables, wherein said plurality of process control variables include a temperature, a flowrate, a pH, a dissolved oxygen concentration, *a dissolved nitric oxide concentration*, an antibiotic concentration and *an endotoxin concentration*;

separating the islets from the portion of pancreas; and

collecting the separated islets.

38. A method for isolating islets from a pancreatic tissue, comprising:

a step for introducing the pancreatic tissue to an islet processing solution that contains a digestive enzyme and that is characterized by a plurality of process control variables;

a step for circulating said islet processing solution through the pancreatic tissue;

a step for controlling said plurality of process control variables of the islet processing solution during islet isolation, the plurality of process control variables comprising: a temperature, a pH, a flowrate, a dissolved oxygen

concentration, *a dissolved nitric oxide concentration, a nitric oxide synthase activity, an endotoxin concentration, an endotoxin neutralizing protein concentration, an antibiotic concentration, an amino acid concentration, a dextran concentration, a heparin concentration, and a digestive enzyme activity;*

a step for separating the islets from the pancreatic tissue while the process control variables are controlled; and

a step for collecting the separated islets.

Regarding dextran concentration, Benedict notes it is not disclosed in the cited prior art, but offers no other argument.

[11] We note that dextran is a saccharide sometimes used to regulate osmotic pressure, much like the other saccharides that Mullen lists as impermiants.

The previous decision on Benedict Motion 3 already addresses the endotoxin, nitric oxide and nitric oxide synthase limitations. In that decision, we found that Benedict's specification identified art-recognition of the need to control these factors and methods to do so.⁴⁷

We conclude in the context of this motion that these differences would have readily occurred to those skilled in the art.

E. Holding

The subject matter of Rilo involved claim 80 and Benedict involved claims⁴⁸ 1-50 was not patentable over the prior art as illustrated in the Mullen, Kearney, and Shuler patents.

⁴⁷ Paper 37.

⁴⁸ When determining patentability in an interference, claims stand or fall together to the extent they are not argued separately. *In re Van Geuns*, 988 F.2d 1181, 1186 (Fed. Cir. 1993)

IV. REPOSE

A. Introduction

Benedict argues that 35 U.S.C. 135(b)(1) bars Rilo's involved claims.⁴⁹ Rilo has conceded all of its claims but claim 80; hence, we focus on Benedict's arguments as they pertain to Rilo claim 80.

B. Facts and findings

Benedict's involved patent issued on 16 May 2006, which establish a critical date under § 135(b)(1) of 16 May 2007.⁵⁰

[12] It is not clear on what date Rilo filed claim 80, but from the argument and admitted facts, we understand it to have been filed after the critical date.

Rilo claims 62-79 were timely copied from Benedict's patent, but were subsequently rejected for lack of written description.⁵¹ In response, Rilo amended its claims.⁵²

C. Analysis

1. *Presumption of materiality*

Under § 135(b)(1) a post-critical date claim may nevertheless be maintained if it is not materially different from a timely claim, but an amendment creates a presumption of a material difference.⁵³ Rilo argues that the presumption is raised by added limitations, as was the case in the cited precedent, but not by deleted limitations. Benedict relies on a single-judge order in an unrelated interference for the proposition that written

⁴⁹ Paper 27 (Benedict Mot. 4) at 4.

⁵⁰ Paper 46 (Benedict Reply 4) at 6, admitted mat'l fact 2.

⁵¹ *Id.*, mat'l facts 3-9.

⁵² *Id.* at 6-7, mat'l facts 10 & 11.

description problems are material.⁵⁴ The logic of the precedent does not permit a categorical statement about the relationship between materiality and typical rejections and amendments. A prior art rejection ordinarily results in narrowing amendments, while amendments to address formalities are not necessarily narrowing. At most, rejections for formalities are more likely to result in amendments more in the nature of a clarification rather than a change in scope. It is important to remember that amendment only creates a presumption, which must be evaluated in the context in which it arises.

The present case presents a problem of first impression, however. After the examination in question, the Court of Appeals for the Federal Circuit reaffirmed its commitment to a non-statutory written-description test for copied claims.⁵⁵ Since the examiner applied the statutory standard rather

⁵³ *In re Berger*, 279 F.3d 975, 982-83 (Fed. Cir. 2002); *Corbett v. Chisholm*, 568 F.2d 759, 765 (CCPA 1977).

⁵⁴ *Barany v. McGall*, Intf. 105,351, Paper 59 (6 February 2009) (Exh. 1012).

⁵⁵ See *Koninklijke Philips Elecs. N.V. v. Cardiac Sci. Operating Co.*, 590 F.3d 1326, 1332 (Fed. Cir. 2010) and *Agilent Techs., Inc. v. Affymetrix, Inc.*, 567 F.3d 1366 (Fed. Cir. 2009), applying *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992) (explaining that a claim copied for interference purposes is viewed in the context of the patent from which it was copied). That this test differs from the statutory test is apparent from at least 35 U.S.C. 112(6) (requiring reference to the host application). It also appears to contradict considerable Supreme Court precedent. *E.g.*, *Am. Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 5 (1931) ("The claim of a patent must always be explained by and read in connection with the specification."), citing *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 432 (1902); also *Bates v. Coe*, 98 U.S. 31, 38 (1878) (same); citing *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853). It also undermines Federal Circuit presumptions based on patent examination since the court has expressly rejected using the non-statutory test in invalidity determinations. *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1332 (Fed. Cir. 2000). Since these presumptions underlie the Federal Circuit's clear-and-convincing

than the Federal Circuit's standard to the claims, it is not clear what the effect of the rejection and responsive amendment should be. Rilo disputes their materiality.⁵⁶ The earlier board order does not help since it too pre-dates the Federal Circuit's reimposition of non-statutory written description.

2. Earlier support

In any case, Rilo points to an even earlier claim, claim 46, for support. Claim 46, read in conjunction with its parent claim 45, defined the invention as:⁵⁷

A method for optimizing a process of isolating a subpopulation of cells comprising:

digesting an organ or other biological material in a medium within a recirculation loop to form a subpopulation of cells;

maintaining a fluid flow of said medium through said recirculation loop;

providing a computer operatively connected to said recirculation loop for operatively controlling at least one parameter of the isolation of said subpopulation of cells; and

periodically removing cells from said subpopulation of cells and comparing the cells to a standard to determine the extent of digestion[;]

...wherein said at least one parameter is selected from the group consisting of temperature, pressure, pH, and dissolved oxygen concentration.

evidentiary standard for invalidity, the *Spina* standard has significant implications for the security of patent claims in invalidity determinations. *Cf. Microsoft Corp. v. i4i Ltd. P'ship*, 131 S.Ct. 647 (2010) (granting cert. to consider the clear-and-convincing standard).

⁵⁶ Paper 43 (Rilo Opp. 4) at 3-4.

⁵⁷ *Id.* at 1-2.

Rilo contends that this claim shows an intent to claim the critical limitations related to flow before the critical date.⁵⁸

Benedict's reply argues that the "at least one" language fails to support an intent to claim all of the listed parameters simultaneously.⁵⁹ Benedict also argues that claim 46 would have been unpatentable.⁶⁰ At oral argument, Benedict belatedly also argued that claim 46 materially failed to address application of the process to isolating pancreas islets.⁶¹

Benedict has a point about claim 46 likely being unpatentable since we have held all of the involved claims to have been unpatentably obvious. By the same token, however, it makes unpatentability moot as a point for distinguishing the claim. Indeed, arguably, the entire motion is moot.

The argument about claim 46's failure to identify isolating pancreas islets is impermissibly new and is moot for that reason alone.

For the sake of completeness, we address the "at least one" and lack of pancreas arguments. The "at least one" argument is necessarily weak since the express terms of the claim would cover use of all of the listed parameters. Benedict must give some reason why selection of all of the listed parameters would be a material change. Similarly, the lack of pancreas argument fails to account for the timely claims that did address isolating pancreas islets. Precedent permits support—⁶²

⁵⁸ *Id.*

⁵⁹ Paper 46 at 2.

⁶⁰ *Id.* at 2-3.

⁶¹ Paper 58 (Transcript) at 4-5.

⁶² *Corbett*, 568 F.2d at 766.

to be gathered from the perusal of a group of related claims to the same invention and that which is to be gathered from the perusal of a group of claims to related inventions.

We cannot presume that the claims are necessarily directed to different inventions.⁶³ Even if this argument were not new, Benedict fails to explain why combining elements from related claims (or related inventions) derived from the same disclosure would necessarily constitute a material difference.

Benedict has failed to meet its burden for its motion 4.

V. CONCLUSION

All of the involved claims are unpatentable. A separate judgment will follow.

cc:

John Garred, Susan Mizer, and Michael Hudzinski, TUCKER ELLIS & WEST LLP, of Cleveland, Ohio.

Robert Hahl and Rick Neifeld, NEIFELD IP LAW, PC, of Alexandria, Virginia.

⁶³ *Id.* at 767.